

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Art Unit : 1745
Examiner :
Serial No. : 10 045,848
Filed : November 7, 2001
Inventors : Hiroki Nakamaru
: Tomoshige Ono
: Yoshiei Kato
Title : IRON POWDER FOR
: REMEDIATION AND
: METHOD FOR REMEDIATING
: SOIL, WATER, OR GAS



22469

Docket No.: 1315-01

Confirmation No.: 2392

Dated: November 12, 2002

RENEWED REQUEST FOR RECONSIDERATION

Box DAC
Commissioner for Patents
Washington, DC 20231

Sir:

This renewed Request for Reconsideration is submitted in response to the Decision on Petition dated September 10, 2002. Reconsideration is respectfully requested.

The Applicants first note with appreciation the courtesy extended by Examiners Brantley, Pearson and Hearn on October 24, 2002 in discussing selected aspects of this case, especially with respect to clarifying which papers are physically present in the Official PTO File and the handling of the original Application papers with respect to decontamination procedures having been applied to those papers.

* * *

The Applicants wish to briefly review the sequence of events on the Applicants' side for clarification purposes and to respond directly to the Examiner's specific question concerning the order of review of the Application papers by the Declarants. The sequence of events was as follows:

Ms. Ginola Johnson prepared the Application papers for filing in the PTO. This included preparation of an original Application to be filed in the PTO, a copy of the Application papers for the file of the undersigned and a copy of the Application papers to be sent to the Applicants. Ms. Johnson 1) physically clipped the copy for the file into the file, 2) fixed the original Application papers together as a package, attached to but not in the Express Mail Envelope, and 3) fixed the copy

for the Applicants to a letter to be sent to the Applicants. Ms. Johnson counted the pages in the application package, among other things. They were all present.

The file was hand-carried to Ms. Regina Belitz, who counted the pages in the Application package. They were all present. She performed several other quality checks such as inventors' information, and the like.

The file was then hand-carried to the undersigned by Ms. Belitz for final review, including counting the pages, and signature. The undersigned, in fact, counted the pages and found them all present, conducted the final review, signed the Application papers in the appropriate location and returned the signed Application package to Ms. Johnson, who thereupon placed the undisturbed Application papers into the Express Mail envelope and sealed the envelope.

* * *

During the aforementioned telephone discussion, additional relevant facts came to light and were discussed. Further, subsequent to the conclusion of that discussion, additional facts have come to light. They are set forth below for consideration at this time.

It is the understanding of the undersigned that the PTO is in possession of Application papers that are complete with the exception of pages 2, 3, 13, 17 and 19 of the Specification. It is further the understanding of the undersigned that the physical condition of the papers in the possession of the PTO is at least "good", if not "excellent". There is apparently no evidence of the Application papers in the PTO file having been subjected to any type of UV treatment as mentioned in Applicants' earlier Petition.

This is in sharp contrast to the two papers in the possession of the undersigned that were mailed to the PTO and subsequently returned to the undersigned. Specifically, those papers are the postcard accompanying the original Application and the Assignment recordal transmission letter. The Assignment recordal transmission letter was returned to the undersigned along with a PTO Notice of Recordal of Assignment comprising two separate sheets.

As noted in the discussion, the return postcard was subjected to what appears to be UV irradiation, inasmuch as it is discolored, brittle and two of the four corners have been broken away. It appears to be prematurely aged, as is typical of UV irradiation. Similarly, the Applicants'

Assignment recordal transmittal sheet is discolored and extremely brittle. In fact, at the two creases where it was folded to be placed into an envelope, one creased portion has broken loose and is essentially disconnected from the remainder of the sheet. However, the Notice of Recordation of Assignment document is not discolored and or brittle or appearing to be prematurely aged. This document accompanied the Applicants' Assignment transmittal sheet from the PTO to the office of the undersigned. Therefore, it is clear that those documents were not subjected to UV treatment at the time those documents left the PTO or thereafter. The only possible conclusion is that the Assignment recordal sheet was subjected to treatment upon receipt at the PTO or at some point prior to reaching the PTO by virtue of actions taken by the USPS.

The Application papers submitted by the undersigned were original papers bearing original signatures in blue ink. Those papers included a transmittal letter, in duplicate, and the aforementioned Assignment recordal transmittal sheet. Also, the Express Mail Certification executed by Ms. Johnson was an original document executed in blue ink. It is our understanding from a conversation with Examiner Brantley that the papers present in the Official File are copies of the originally submitted papers inasmuch as the PTO papers are not blue ink executed original papers. We respectfully request that the PTO confirm that the papers in the Official File are, in fact, copies and not blue ink executed originals. We submit herewith as Appendix A an exact copy of all of the papers as originally filed for comparison with those of the PTO file to verify whether there are relative changes in size, font, etc. based on the apparent copying, at the PTO, of the original Application papers prior to being placed into the Official File.

Although this Application was filed on November 7, 2001 and the undersigned has filed many applications in the PTO since that time, the undersigned has a specific recollection of filing this application in its entirety, including the missing pages, by virtue of several unusual facts associated with this application. The first fact causing the undersigned to have specific recollection of this application is that another application (Serial No. 10 045,316) having highly related subject matter and containing two of the three inventors for this application was filed by the undersigned on the same day utilizing exactly the same procedure. Special attention was paid to both of these Applications inasmuch as the Applicants specifically requested that the applications be filed on the

same day. Great caution was exercised to avoid confusion between the two Applications.

Another relevant fact is that the subject matter of this Application (as well as the other Application) is somewhat unusual relative to the subject matter of the many applications handled by the undersigned on behalf of the assignee corporation. These Applications relate to methods of remediating contaminated soil, which is sharply different from the usual subject matter of the assignee corporation.

Yet another fact raising special attention for this Application (as well as the other Application) is that the undersigned has for many years prepared and filed patent applications for a completely separate client involving many methods of remediating soil. Accordingly, the particular technology of this application "stood out" and occupied a place of greater interest than usual.

As a result of the above facts, the undersigned has a specific recollection of filing this Application (as well as the other Application) and counting the pages of both Applications to ensure that they were all present. The pages were, in fact, present in both applications at that time.

Inasmuch as the other Application was filed on the same day as the Application at issue here, the undersigned checked that file to see if there were any problems associated with the filing of that Application. That check revealed additional relevant facts for this Application. First, the return postcard for that Application has never been returned from the Patent Office. Of greater importance, however, is that the Assignment recordal transmittal letter has been returned from the PTO attached to the usual Notice of Recordation of Assignment. As was the case in this Application, the PTO Notice in the other application is in excellent condition and was not subjected to UV treatment. However, the original Assignment transmittal form that was submitted to the PTO with the other Application bears the same indicia of UV treatment. Specifically, it is highly discolored and quite brittle. In fact, the two locations where the form was folded to be placed into the PTO envelope are not only brittle, but have completely broken apart and were subsequently taped together to maintain the integrity of the document. A copy of that Assignment recordal form is attached as Appendix B.

Further review of the other file reveals that the PTO telephoned the undersigned and requested certain replacement pages for originally filed, irradiated pages in that Application. The

PTO characterized the papers as having been "irradiated". Those certain pages were apparently in such poor condition to be virtually unuseable. Those items included the Express Mail Certificate, page 24 of the Application, which was in that case the Abstract, and two sheets of drawings. The undersigned, at the request of Ms. Santissa Inman of the PTO, faxed replacement pages to the Patent Office on April 2, 2002. Copies of those papers are also attached as Appendix C.

* * *

It is apparent, from a thorough review of the Applicants' file, information obtained from Examiner Brantley about the Official File at the PTO, as well as the file of the other Application filed on the same day in the Patent Office, that this Application was mailed with all of its pages present, and was subjected to procedures out of the ordinary course of procedures typically undertaken by the Patent Office during "normal" times. There is ample evidence that both Applications were subjected to irradiation treatment, that at least this Application was photocopied by unknown persons, either at the USPS or USPTO, and that, at some point during that process, the pages at issue were lost or misplaced. We accordingly respectfully submit that the Applicants have clearly complied with all of the applicable rules and have established on a factual basis that the pages at issue were filed in the PTO on November 7, 2001. The Applicants, therefore, respectfully request that pages 2, 3, 13, 17 and 19 be entered into the Official File and accorded the same filing date as the remainder of the Application.

Respectfully requested,



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